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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/158,728	09/22/1998	STEVEN CRAIG WEIRATHER	310048-355	4296

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LOS ANGELES, CA 900673024

EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/08/2003

36

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/158,728

Applicant(s)

WEIRATHER ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/5/02, 6/27/02, 10/16/02 and 1/28/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>28,30,3</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 282-288,290,293,295,297-299,302-307,309-316,318-320,322-330,333,336-342,344,346,347,349,351-353,356-361,363-370,372-374,376-383,386 and 389-428.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 283,286,288,293,313-316,318-320,322,327,333,338,340,342,347,367-370,372-374,376,380,386,397,398,400,405,406 and 408.

Continuation of Disposition of Claims: Claims rejected are 282,284,285,287,290,297-299,302-307,309-312,323-326,328-330,336,337,339,341,344,346,349,351-353,356-361,363-366,377-379,381-383,389-396,399,401-404,407 and 409-428.

RESPONSE TO AMENDMENT

Election/Restrictions

1. Applicant's election with traverse of Species A, F, H and K in Paper No. 34 is acknowledged. The traversal is on the ground(s) that Species H and I or not necessarily independent and distinct. This is not found persuasive because Applicant is claiming two different embodiments for thinning the edges. The first embodiment where the infeed edge of the sheet of printable media is calendared, a.k.a. crushed or compressed. The second embodiment is where the facestock material and liner sheet, which comprise the printable media, are different sizes thus the edge of the printable media is only on layer instead of two. These are two separate and materially different ways of thinning the edge of the printable media. It is noted that claim 320 and 374 disclose the printable media comprising both embodiments for thinning the edge as point out in figures 26 and 28. At the present time they also contain a non-elected species and are therefore withdrawn. However, if upon finding Applicant's chosen species H "calendaring" allowable, claims 320 and 374 will be subject to rejoinder.

Applicant further argues that while J relates to the construction of each of the printable media, K relates to the arrangement of the printable media. At the present time, in view of the claim language, the examiner construes the claims of species J to read on the arrangement of the printable media and therefore restriction is proper. However, Applicant may amend the claims in species J to more clearly show that the claims are directed to the construction of the printable material, instead of the arrangement. If Applicant amends to clearly show the claims are direct to the construction and not the arrangement the restriction will be withdrawn.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

2. The information disclosure statement filed October 24, 2002 (paper #28) and March 21, 2003 (paper #35) fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because there are no translations, English abstracts or search report for references NO 156959, DE 2257435 CA, or DE 197 41 562 A1. The references have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

NEW REJECTIONS

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Double Patenting

4. Claim 390 is objected to under 37 CFR 1.75 as being a duplicate of claim 285. When two claims in an application are duplicates or else are so close in content that they both cover the

Art Unit: 1772

same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

5. Claims 282, 284, 285, 287, 290, 297, 298, 299, 302-307, 309-312, 323-326, 328-330, 336, 337, 339, 341, 344, 346, 349, 351-353, 356-361, 363-366, 377-379, 381-383, 389-396, 399, 401-404, 407 and 409-428 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms “facestock sheet construction,” “facestock sheet,” “cardstock sheet” and “printable media” in claims 282, 284, 285, 287, 290, 297, 298, 299, 302-307, 309-312, 323-326, 328-330, 336, 337, 339, 341, 344, 346, 349, 351-353, 356-361, 363-366, 377-379, 381-383, 389-396, 399, 401-404, 407 and 409-428 are unclear which renders the claims vague and indefinite. It is unclear from the specification and the claim language how these terms differ. They all seem to be interchangeable and refer to the same thing, the top layer of the sheet of printable media. For purposes of examination they are taken to be the same and only refer generically to a top layer of the sheet of printable media.

Note: The limitation “the lead-in edge of the sheet of printable media is calendared” is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendared end thinner. So, for purposes of examination any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation “the lead-

Art Unit: 1772

in edge of the sheet of printable media is calendared,” since the method of forming the product is not germane to the issue of patentability of the product itself.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 282, 284, 285, 287, 290, 295, 302, 303-307, 309, 323, 324, 328-330, 336, 337, 341, 344, 346, 349, 356-361, 363, 377, 381-383, 389, 390, 392, 396, 409, 414, 415, 420-422, 425 and 426 are rejected under 35 U.S.C. 102(b) as being anticipated by Popat et al. (5,407,718).

Art Unit: 1772

Popat discloses a sheet of printable media comprising a facestock sheet construction and a solid/continuous release liner. The facestock sheet construction comprises through-cut lines (vertical and horizontal) through the facestock sheet but not through the release liner. The through-cut lines on the facestock sheet define a perimeter around the printable media and the printable media directly abut one another and share common edges which is arranged in a matrix. The facestock sheet also comprises frame cut lines and waste border around the printable media. The release line covers all the back side of all the face cut lines and extends the entire width of the facestock sheet construction. See figures 1 and 2.

8. Claims 282, 284, 285, 298, 299, 302, 309, 310, 323, 324, 328, 337, 339, 344, 352, 353, 356, 363, 364, 377, 381, 390, 391, 392, 395, 396, 399, 401, 403, 407, 409, 414, 415, 420, 425 and 426 are rejected under 35 U.S.C. 102(e) as being anticipated by Casagrande (5,782,497).

Casagrande discloses a dry laminate business form with removable cards (col. 1, lines 13-17). The laminate of the invention comprises a topside layer (facestock sheet) which contains writing, graphics or other indicia, a first adhesive layer, a translucent film (film layer) or paper layer, a cast coating (liner sheet), a second adhesive (liner sheet), and a base paper (liner sheet) (figure 1 and col. 2, lines 26-53). The cast coating has a greater affinity for the second adhesive layer than the film or paper layer, which enables the separation of the film or paper layer from the cast coating layer upon removal of the card with cast coating layer remaining attached to the adhesive layer (col. 2, lines 61-65). The top, first adhesive, and translucent film or paper layers are provided with through cut lines which define the business card (figure 1 and col. 2, lines 40-43).

Claim Rejections - 35 USC § 103

9. Claims 287, 290, 295, 303, 304-307, 311, 312, 329, 330, 336, 341, 349, 357-361, 365, 366, 382, 383, 389, 393, 402, 404 and 421-424 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande (5,782,497) in view of Klein (5,198,275).

Casagrande discloses all the limitations of the instant invention except that the printable media comprises a matrix block of cards and surrounded by waste facestock and thickness of the layers.

Klein discloses a card stock sheet for making business cards (col. 2, line 47) or a label (col. 3, line 13) comprising a lift out panel (cardstock sheet) with rectangular score cuts (cut lines), an adhesive, and a backing sheet (liner sheet) with perforations (liner sheet cut lines, defining liner sheet strips) (figure 6). From figure 3 the laminate member can be seen to have rectangular score cuts (frame cut lines) and score cuts (grid cut lines) and the matrix of cards is surrounded by a waste facestock sheet perimeter.

The exact thickness of the layers is deemed to be a cause effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as combined thickness of layers through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

Art Unit: 1772

It would have been obvious to one of ordinary skill in the art at the time of the invention to arrange the cards of Casagrande similar to the arrangement of Klein to include a waste perimeter and a matrix of cards because it would make manufacturing mass quantities of the cards faster and easier.

10. Claims 325, 326, 346, 378, 379 and 394 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande (5,782,497) in view of Hickenbotham et al. (4,704,317).

Casagrande discloses all the limitations of the instant claimed invention except for card sheet of paper sheet is calendered.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (col. 6, lines 9-16). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (col. 1, lines 38-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of Casagrande as similarly taught by Hickenbotham. One of ordinary skill would be motivated to crush the edge of Casagrande because crushing the edge of Casagrande would provide a path of relatively low stiffness and would make the sheet of Casagrande easier to be dispensed through a printer.

11. Claims 282, 284, 285, 287, 290, 295, 297-299, 302-307, 309-312, 323, 324, 328-330, 336, 337, 339, 341, 344, 349, 351-353, 356-361, 363-366, 377, 381-383, 389-396, 399, 401-404, 407, 409, 411, 412, 414, 417, 418 and 420-428 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Cross (4,863,772).

Popat discloses a sheet of printable media comprising a facestock sheet construction (facestock sheet/cardstock sheet and an adhesive) and a solid/continuous release liner. The facestock sheet construction comprises through-cut lines (vertical and horizontal) through the facestock sheet but not through the release liner. The through-cut lines on the facestock sheet define a perimeter around the printable media and the printable media directly abut one another and share common edges which is arranged in a matrix. The facestock sheet also comprises frame cut lines and waste border around the printable media. The release line covers all the back side of all the face cut lines and extends the entire width of the facestock sheet construction. See figures 1 and 2.

Popat discloses all the limitations of the instant claimed invention except for the facestock construction being a dry laminate and the release liner comprising bleach kraft paper.

Cross discloses label stock with dry separation interface comprising a facestock paper, a pressure-sensitive adhesive, a layer of low density polyethylene, and bleached kraft paper release layer (figure 5 and col. 5, lines 1-38).

Cross discloses the claims invention except for the adhesive being a hot melt adhesive or the film layer being polyester. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a hot melt adhesive for the adhesive or polyester for the dry release film layer, since it have been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended. *In re Leshin*, 125 USPQ 416.

It would have been obvious to one having ordinary skill in the art use the dry release label stock of Cross as the label facestock sheet construction of Popat because the dry release

Art Unit: 1772

material would allow the labels of Popat to be nonsticky. One of ordinary skill in the art would be motivated to use a nonsticky label depending upon its intended use. Furthermore, it would have been obvious to one of ordinary skill to use a bleached kraft release liner in Popat when using a dry release label stock as taught by Cross because it has better release properties.

The exact thickness of the layers is deemed to be a cause effective variable with regard to size of paper acceptable for sending through a printer. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as combined thickness of layers through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated to change the size of the layers in order to accommodate the machine in which the sheet was intended to be used in.

12. Claims 325, 326, 346, 378, 379 and 394 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Cross (4,863,772) as applied to claims 282, 284, 285, 287, 290, 295, 297-299, 302-307, 309-312, 323, 324, 328-330, 336, 337, 339, 341, 344, 349, 351-353, 356-361, 363-366, 377, 381-383, 389-396, 399, 401-404, 407, 409, 411, 412, 414, 417, 418 and 420-428 above, and further in view of Hickenbotham et al. (4,704,317).

Popat and Cross disclose all the limitations of the instant claimed invention except for card sheet of paper sheet is calendered.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (col. 6, lines 9-16). The low stiffness in the

Art Unit: 1772

front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (col. 1, lines 38-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the combination of Popat and Cross as similarly taught by Hickenbotham. One of ordinary skill would be motivated to crush the edge of the combination of Popat and Cross because crushing the edge of the combination of Popat and Cross would provide a path of relatively low stiffness and would make the sheet of the combination of Popat and Cross easier to be dispensed through a printer.

13. Claims 410, 413, 416, 419 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popat et al. (5,407,718) in view of Cross (4,863,772) as applied to claims 282, 284, 285, 287, 290, 295, 297-299, 302-307, 309-312, 323, 324, 328-330, 336, 337, 339, 341, 344, 349, 351-353, 356-361, 363-366, 377, 381-383, 389-396, 399, 401-404, 407, 409, 411, 412, 414, 417, 418 and 420-428 above, and further in view of Carlson (5,842,722).

Popat and Cross disclose all the limitations of the instant claimed invention except for card sheet/ facestock sheet is coated.

Carlson discloses a sheet for preparing business forms including die cut cards, which includes an ink receptive coating (abstract and col. 19, line 50 through 3).

It would have been obvious to one of ordinary skill in the to add an ink receptive coating to the combination of Popat and Cross as taught by Carlson because it would enhance the adhesion of the ink to the card.

Art Unit: 1772

ANSWERS TO APPLICANT'S ARGUMENTS

14. Applicant's arguments in papers #23, #26, #29, and #34 about the previous 35 U.S.C. §112, §102 and §103 rejections of record are moot since Applicant has canceled the claims to which those rejections were applied.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

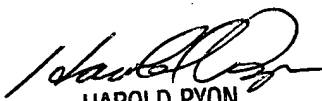
If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

4/3/03




HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

4/4/03